

AMENDMENTS TO THE DRAWINGS

The attached one (1) sheet of drawings include Fig. 3 and replaces Fig. 3 in originally filed sheets 1 – 7 of drawings. Specifically, in response to the above Office action, one of two instances of “395” is replaced with --396-- as described in the specification as filed. No new matter is added.

REMARKS

Claims 1 – 46 remain in the application and stand rejected. Claims 1, 4, 7, 9 – 12, 14 – 18, 20 – 25, 28, 30, 32, 35, 37 and 39 – 46 are amended herein. Although this amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

The drawings are objected to for including two instances of “395” on Fig. 3. Responsive thereto, on the attached replacement sheet, one of two instances of “395” is replaced with --396-- as described in the specification as filed, e.g., on page 23, lines 19 – 25. No new matter is added. Reconsideration and withdrawal of the objection to the drawings is respectfully requested.

Claim 11 is objected to for lacking a verb. Partially responsive thereto, claim 11 (and 41) is amended to include a verb. Further, claims 15 and 43 are amended to replace “furthering” with --further--. Reconsideration and withdrawal of the objection to claim 11 is respectfully requested.

Claims 4, 10, 17 and 35 are rejected under 35 U.S.C. §112 for lacking antecedent basis for “protocol device.” Responsive thereto, claims 4, 10, 17 and 35 are amended to recite a SIP or CSTA device, which is supported by the claims from which the rejected claims depend, by the specification and by the understanding in the art of a SIP device and a CSTA device. No new matter is added. Reconsideration and withdrawal of the rejection of claims 4, 10, 17 and 35 under 35 U.S.C. §112 is respectfully requested.

Claims 1, 4, 7, 9 – 12, 14 – 18, 20 – 25, 28, 30, 32, 35, 37 and 39 – 46 are amended herein to better recite the invention and, in particular, to recite providing full Instant Messaging (IM) capability to telephone sets. *See, e.g.*, claim 22, the Abstract, lines 1 – 2 (“providing Instant Messaging (IM) capability in digital telephone sets”), page 3, line 21 (“provides IM using traditional telephone sets and allows, e.g., IM between those telephone set users and PC users or

IM between users of telephone sets. The present invention is a systems for providing IM between digital display telephones”) – page 4, line 15 and page 5, line 22 – page 7, line 8.

More particularly, claim 1, recites that “at least one of said first device and said second device is a telephone set with a keypad having a fixed number of key buttons and a display;” and that “full IM capability is provided to said telephone set.” This is neither shown nor suggested by any reference of record and is supported by claim 22 and, generally, by the specification, e.g., page 4, lines 4 – 7 (“the invention defines a process by which a digital telephone set, with limited keys and display space, can support the full functionality of IM including, e.g., composing messages, responding to messages and creating a buddy list.”). Independent claims 14, 32 and 42 include analogous recitations. No new matter is added and this is neither shown or suggested by any reference of record.

Claims 7 and 37 are amended to recite “instant messaging being displayed on said display.” This also is supported by page 4, lines 4 – 7. No new matter is added and this is neither shown or suggested by any reference of record.

Claims 9 and 39 are amended to recite “and full IM capability includes composing messages, responding to messages and creating a buddy list.” This also is supported by claim 22 and by page 4, lines 4 – 7. No new matter is added and this is neither shown or suggested by any reference of record.

Further, claims 4 and 35 are amended to recite that the “SIP device [manages and determines] presence information for a respective IM user.” This is supported by the specification, e.g., page 7, lines 5 – 7 (“In the preferred embodiment of the present invention, the SIP/SIMPLE protocol is responsible for managing and determining the presence information of the IM user.”). No new matter is added and this is neither shown or suggested by any reference of record.

Claims 11, 18, 41 and 46 are amended to recite that “at least one key button is a programmable key.” This is supported by the specification, e.g., page 8, lines 19 – 20

(“telephone set with a digital display and at least one, and preferably more than one, programmable keys.”). No new matter is added and this is neither shown or suggested by any reference of record.

Claims 12 is amended to recite that the “telephonic switch [monitors] said key buttons and having full control of said display.” This is supported by the specification, e.g., page 5, lines 30 – 32 (“monitors the telephone set activity and key usage, receives information for any keys pressed at the telephone set and has full control of the telephone set display.”). No new matter is added and this is neither shown or suggested by any reference of record.

Claims 20 is amended to recite that the “digital telephone set [displays] a new instant message notification in response.” This is inherent in instant messaging and, further, supported by the specification, e.g., page 12, lines 9 – 10 (“the CSTA application sets the LED for the requested client to blink at 420.”). No new matter is added and this is neither shown or suggested by any reference of record.

Claims 1 – 19, 21, 24 and 32 – 46 are rejected as being unpatentable under 35 U.S.C. §102(e) over U.S. Patent Application number 2004/0205209 to Wengrovitz et al. Claims 20, 22 and 28 – 31 are rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. in view of U.S. Patent Application number 2005/0013421 to Chavez et al. Claim 23 is rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. in view of U.S. Patent Application number 2005/0059418 to Northcutt. Claim 25 is rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. in view of D.E. Patent number DE10127360 to Jerbi et al. Claims 26 and 27 are rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. in view of U.S. Patent Application number 2005/0108348 to Lee.

In rejecting claim 22, the Office action acknowledges that “Wengrovitz does not explicitly teach: communicating includes composing and displaying instant messages using the standard key buttons and display space of said digital telephone set.” However, “composing and displaying instant messages” is inherent in full IM capability. Therefore, Wengrovitz fails to teach the present invention as recited in claims 1 – 19, 21, 24 and 32 – 46, as amended.

Reconsideration and withdrawal of the rejection of claims 1 – 19, 21, 24 and 32 – 46, under 35 U.S.C. §102(e) is respectfully requested.

Regarding obviousness of claims 20, 22 and 28 – 31, while Chavez et al. teaches composing, sending and receiving instant messages, this is not necessarily full IM capability. For example, one IM feature Chavez et al. fails teach is “creating a buddy list” such as is specifically recited in claims 9 and 39. *See, e.g.*, Chavez et al. paragraph 0065 (“When an original message is being generated and transmitted by the communication device, the destination can be indicated by inputting ..., or by selecting the destination from a predetermined or preselected list of addresses (such as a contact list ... [or] to an external communication device, ... selected from among a set of preselected destinations ...”). Therefore, Chavez et al. fails to teach providing full IM capability to the telephone set and, the combination of Wengrovitz et al. with Chavez et al. fails to result in the present invention as recited in claims 20, 22 and 28 – 31. Reconsideration and withdrawal of the rejection of claims 20, 22 and 28 – 31, under 35 U.S.C. §103(a) is respectfully requested.

Regarding obviousness of claim 23, 25, 26 and 27, none of Northcutt, Jerbi et al. or Lee, teaches providing full IM capability to the telephone set. Therefore, combining Wengrovitz et al. with Northcutt, Jerbi et al. or Lee fails to result in the present invention as recited in claims 23, 25, 26 and 27. Reconsideration and withdrawal of the rejection of claims 23, 25, 26 and 27, under 35 U.S.C. §103(a) is respectfully requested.

The applicants have considered the other references cited, but not relied upon and find them to be no more relevant than the references upon which the rejection is based.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 – 46 under 35 U.S.C. §§102(e) and 103(a) and allowance of the application to issue.

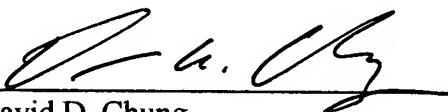
Applicants note that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed **and that if properly claimed such claims may be given favorable consideration.**

(emphasis added). The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

November 20, 2007
(Date)


David D. Chung
Reg. No. 38,409
Attorney for Applicants
Direct Dial: (408) 492-5336
Dept. Fax: (408) 492-3122

Siemens Corporation
Customer Number: 28524
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830

Amendment in response to
August 23, 2007 Office action

Atty Dkt No.: 2003P02177US
Serial No.: 10/761,059

APPENDIX